

Appl. No. 10/633,743  
Atty. Docket No. 9018M2  
Amdt. Dated 22 September 2005  
Reply to Office Action of 01 September 2005  
Customer No. 27752

## REMARKS

### Claim Status

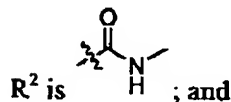
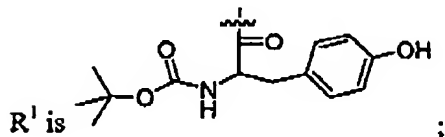
Claims 1 - 21 are pending in the present application. Herein, Applicants present no amendments to the claims, add no new claims, and cancel no claims. No additional claims fee is believed to be due.

### Response to Requirement for Restriction of Inventions

The Examiner has required, under 35 USC §121, election of a single disclosed invention for prosecution on the merits. Pursuant to this requirement, Applicants hereby elect to prosecute the invention designated in the Office Action as Group I. Claims 1-18, and 21 are drawn to this invention. This election is made with traverse.

The Office has also required, in the event that Group I or II is elected, a further election under 35 USC §121, of a single disclosed species for prosecution on the merits. Pursuant to this requirement, Applicants hereby elect to prosecute the species of Example 63. Moieties in Example 63 correspond to substitutions in claim 1 as follows:

The moiety -NHSO<sub>3</sub>H is at para position on the phenyl ring;



R<sup>3</sup>, R<sup>4a</sup>, R<sup>4b</sup>, R<sup>4c</sup>, and all R<sup>5</sup> are hydrogen.

Claims 1-7, 16, 18, and 21 are drawn to this invention. This election is made with traverse.

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### Traversal of Restriction Requirement

The traversal of the indicated restriction requirement is made as it is considered by Applicants to be improperly made.

MPEP §803 sets forth the criteria for any restriction requirement, providing that there are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (1) The inventions must be independent or distinct as claimed; and
- (2) There must be a serious burden on the examiner if restriction is not required.

The Examiner alleges that these inventions are distinct. Applicants respectfully submit that the claims of Group I and II are closely interrelated and in order to preserve unity of invention, all the claims should be prosecuted in the same application. The claims of Group I are related to chemical compounds, while the claims of Group II are directed toward using those compounds to treat various diseases.

Another reason stated by MPEP §803 for restriction requirements is the undue burdensome effect on the Examiner in searching the relevant art. In this instance, although the Office Action has noted two Groups, searching of Group II involves searching only one more class, namely 514. Therefore, Applicants submit that there is no undue burden of search on the Examiner.

The claims of the instant application are directed to compounds and methods of use of these compounds. The Federal Circuit has held in *In re Ochiai*, 71 F.3d 1565 (Fed. Cir. 1995), "From the standpoint of patent law, a compound and all of its properties are inseparable. *Id* at 1572. "[T]he compounds and their use are but different aspects of, or ways of looking at, the same invention and consequently that invention is capable of being claimed both as new compounds or as a new method or process of bonding/priming." *Id.* at 1572. In other words, *Ochiai* holds that a compound and a method/process of using those compounds are the same invention. Therefore, a restriction requirement separating the prosecution of claims to compounds from the prosecution of claims to methods of using those compounds would be deemed improper.

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Applicants note that Office Action has suggested that in accordance with MPEP §821.04 and *In re Ochiai*, 71 F.3d 1565 (Fed. Cir. 1995), rejoinder of product claims with process claims commensurate in scope with the allowed product claims will occur following a finding that the product claims are allowable.


The claims of the instant application are directed towards compounds that are inhibitors of protein tyrosine phosphatases. Further, Applicants submit that compounds of the invention belong to a group that Applicants describe as "phenethylamino-sulfamic acids" (e.g., the title of the application). Therefore, Applicants submit that claim 1 should be examined as submitted and the requirement for an election of species should be withdrawn.

#### Conclusion

This response represents an earnest effort to place the application in proper form. In view of the foregoing, reconsideration of this application and examination of claims 1-18 is respectfully requested.

Respectfully Submitted,

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